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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 1285

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on 09/29/2009

Signature /Jamie Cameron/

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Application Number	Filed
09/498,515	02/04/2000

First Named Inventor: Howard G. Page

Art Unit	Examiner
3622	Yehdega Retta

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 55,827.
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

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09/29/2009
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

Practitioner's Docket No. 1285 **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Howard G. Page
Application No.: 09/498,515
Filed: 02/04/2000
Confirmation No.: 8911
Group No.: 3622
Examiner: Yehdega Retta
For: ADVERTISING INSERTION FOR A VIDEO-ON-DEMAND SYSTEM

Mail Stop: AF
Commissioner for Patents
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Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Advisory Action dated 08/20/2009, and the Final Office Action dated 05/29/2009, Applicant requests review of the Final Rejection in the above-identified application. No amendments are being filed with this request. A Notice of Appeal under 37 C.F.R. § 41.31(a)(1) is being filed herewith. The review is requested for the reasons provided in the following remarks.

REMARKS

Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected and remain pending. Claims 2-4, 6, 9, 13-16, 19, and 22-27 were canceled in previous responses. Applicant respectfully requests consideration of the following remarks and allowance of the claims.

35 U.S.C. § 103 Rejection

Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,718,551 (hereinafter Swix) in view of U.S. Patent No. 6,698,020 (hereinafter Zigmond) in view of "NDS: NDS' XTV™ Time Shifting Technology Empowers the Viewer and the Broadcaster," M2 Presswire (Sept. 10, 1999) (hereinafter XTV), and further in view of U.S. Patent No. 6,588,015 (hereinafter "Eyer"). The Final Office Action mischaracterizes the prior art and thus represents clear error. The conclusion of obviousness requires modification of the references' fundamental principles of operation and this represents further error. Applicant respectfully disagrees with the rejection and requests review for at least the following reasons.

Claim 1 recites, in part, "transferring the insertion point." As discussed in Applicant's previous response, the rejection in the Final Office does not identify the *transfer* of an *insertion point* within the cited references (*see* Final Office Action, page 4, ¶1, lines 4-6). The Final Office Action states "it would have been obvious . . . to transmit the non-continuous broadcast program such as the insertion point or signal" (Final Office Action, page 5, ¶1, lines 7-8). However, an insertion point is a piece of data which is fundamentally different than the data which makes up a broadcast program (*see* Advisory Action, pg. 2, ¶ 2). The Final Office Action's conclusion of obviousness is based upon the suggestion that an insertion point is an example of broadcast programming data (Final Office Action, page 5, ¶1, lines 7-8). This is a mischaracterization of broadcast programming as it is used in the prior art.

Equating the Swix broadcast server's identification of advertisement slots to the insertion points of claim 1 is a further mischaracterization of the prior art (Final Office Action, page 4, ¶1, lines 4-6). In Swix, the broadcast server identifies advertisement slots and manages the advertisement synchronization process using a transient electrical

signal, a q-tone (Swix, col. 12, lines 61-67). The advertisement slot is not an "insertion point compris[ing] data indicating where in the selected video content the selected video advertising is to be inserted" as recited in claim 1. An advertisement slot is not a piece of data referring to a specific location within the video content (*see* Advisory Action, pg. 2, ¶ 2). The Advisory Action responds by indicating "Swix teaches the broadcasting server delivers the continuous broadcast program in one channel and delivers other programs and advertisement in other channel" (Advisory Action, pg. 2, ¶4). It is a mischaracterization to equate the indication of predetermined advertising slots using a q-tone to the *insertion points* of claim 1.

In addition, "transferring the insertion point . . . over the second transport system," as recited in claim 1, is not obvious in light of Swix and Zigmond because each reference specifically teaches away from this approach. Swix and Zigmond both teach centralized systems which maintain control of the advertisement synchronization process. Similar to Swix, Zigmond uses a triggering signal to command the target device to immediately change channels (Zigmond, col. 17, lines 27-31). Transferring the insertion point to the target viewer device, as recited in claim 1, is a fundamentally different solution because an insertion point contains data which allows the *target device* to manage the insertion process. Therefore, claim 1 is not obvious in light of Swix, Zigmond, or the combination.

Furthermore, claim 1 cannot be obvious over Swix and Zigmond because such a finding requires modifying those references to an extent which fundamentally changes their principles of operation (MPEP § 2143.01(VI)). In both references, the signal commanding the target device to switch to advertising content is not sent until a channel or source change is imminent. However, if the Swix or Zigmond target devices had received *insertion points*, as recited in claim 1, they would already have the data necessary to switch to the advertising content at the appropriate time. *The q-tone or trigger signal would no longer be required* and those systems would have *fundamentally different principles of operation*.

Therefore, for at least the reasons discussed above, Applicant contends that claim 1 is allowable in its present form.

The system of independent claim 12 contains limitations similar to those described above with respect to claim 1 and is allowable over the art of record for at least the same reasons discussed above.

Claims 5, 7, 8, 10, and 11 depend from independent claim 1, and claims 17, 18, 20, and 21 depend from independent claim 12. Therefore, dependent claims 5, 7, 8, 10, 11, 17, 18, 20, and 21 are allowable for at least the same reasons discussed with respect to claims 1 and 12.

Applicant respectfully requests allowance of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21.

35 U.S.C. § 112 Rejection

The Advisory Action states "the rejection of 112 2nd is withdrawn" (Advisory Action, pg. 2, ¶ 2). In the Final Office Action, claims 1 and 12 were "rejected under 35 U.S.C. 112, *first paragraph*, as failing to comply with the written description requirement" (Final Office Action, pg. 2, emphasis added). Applicant assumes the rejection in the Final Office Action based upon 35 U.S.C. § 112, first paragraph, is removed with respect to claims 1 and 12.

CONCLUSION

Based on the remarks above, Applicant respectfully submits that claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 are allowable over the art of record. Additional reasons in support of patentability exist, but such reasons are omitted in the interests of clarity and brevity. Applicant respectfully requests allowance of the claims.

A request for a one-month extension of time and the appropriate fee is submitted herewith. Applicant hereby authorizes the Office to charge Deposit Account No. 21-0765 the appropriate fee under 37 C.F.R. § 41.20(b)(1) for the Notice of Appeal filed herewith. Applicant believes no additional fees are due with respect to this filing. However, should the Office determine that additional fees are necessary, the Office is hereby authorized to charge Deposit Account No. 21-0765, accordingly.

Respectfully submitted,

/Todd C. Adelmann/

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